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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)
)
Roland DE LA METTRIE et al.:)
)
Application No.: 09/832,878) Group Art Unit: 1751
)
Filed: April 12, 2001) Examiner: E. Elhilo
)
For: OXIDIZING COMPOSITION AND)
USES FOR DYEING, FOR)
PERMANENTLY RESHAPING OR)
BLEACHING KERATIN FIBRES)
)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

Further to the Restriction requirement of July 23, 2003, please examine this application in view of the following remarks:

I. Status of the Claims

Claims 30-51 are pending in this application.

II. Restriction Requirement

In the Office Action, the Examiner has required restriction between the following groups of claims:

Group I Claims 30-47, drawn to a ready-to-use composition for oxidation dyeing of keratin fibers and its method of using;

Group II Claims 48-49, drawn to a multicompartment kit, and
Group III Claims 50-51, drawn to a method for reshaping keratin fibers.

The restriction requirement, as set forth above and on pages 2-3 of the Office Action, is respectfully traversed. However, to be fully responsive to the restriction requirement, Applicants elect, with traverse, the subject matter of Group I, comprising claims 30-47, drawn to a ready-to-use composition for oxidation dyeing of keratin fibers and its method of using.

As an initial matter, the Examiner has applied the incorrect standard for this restriction requirement. When the PTO considers international applications during the national stage under 35 U.S.C. § 371, PCT Rules 13.1 and 13.2 are to be followed. Here, however, this application is not a national stage application, but is a divisional application pursuant to 37 C.F.R. 1.53(b). "Applications submitted under 37 C.F.R. 1.53(b)...are applications filed under 35 U.S.C. § 111(a)." M.P.E.P. 201.06(c). The M.P.E.P. further states that restriction (not unity of invention) practice applies to U.S. applications filed under 35 U.S.C. § 111(a) "even if the application...claims priority to an earlier international application or to an earlier U.S. national stage application... ." M.P.E.P. § 1893.03(d). Therefore, PCT (unity of invention) rules do not apply. Instead, the present restriction requirement should follow the U.S. standard pursuant to 35 U.S.C. § 121. See also M.P.E.P. 1895.01.I.D, page 1800-161.

Thus, Applicants refer the Examiner to M.P.E.P. § 803, which sets forth the criteria and guidelines for Examiners to follow in making proper requirements for restriction under 35 U.S.C. § 121. The M.P.E.P. instructs Examiners as follows:

If the search and examination of an entire application can be made without serious burden, the Office must examine it on the merits, even though it includes claims to distinct or independent inventions.

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M.P.E.P. § 803 (emphasis added).

Here, the Examiner has not shown that examining the above groups together would constitute a serious burden. Applicants further submit that searches for each of these groups of claims should substantially overlap and thus do not represent a serious burden to the Examiner.


Accordingly, for at least the reasons above, Applicants respectfully submit that the restriction requirement is in error and, as such, should be withdrawn.

Finally, for the record, page 2 of the Office Action states that a telephone call was made to Thalia V. Warnement on July 21, 2003. No such telephone call was ever received by the undersigned, and no voicemail or message was left by the Examiner when he attempted to contact her. Thus, neither the undersigned nor the Applicants were aware of the Restriction by the Examiner prior to receipt of the Office Action, contrary to the implication made therein.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P

By: 
Thalia V. Warnement
Reg. No. 39,064

Dated: August 22, 2003

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